

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 17, 2005. At the time of the Office Action, Claims 1-16 were pending in this Application. Claims 1-16 were rejected. Claims 2-7 and 13-15 have been amended to further define various features of Applicants' invention. Claim 1 has been canceled. Applicants respectfully request reconsideration and favorable action in this case.

### **Claim Objections**

Claims 1, 6, and 13-15 were objected to due to informalities. Applicants have canceled Claim 1, and amended Claims 6 and 14-15 to overcome these objections.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-10, and 16 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,650,906 issued to Rainer Marquardt et al. ("Marquardt"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With respect to independent claim 7, Applicants have amended to recite that the feedback path is between the power switch output and an amplifier stage of a driver connected to the control terminal of the power switch. See element 11 of FIG. 2 or FIG. 3A for support of this amendment. The cited reference does not teach either expressly or inherently this feature of the claimed invention. As depicted in both FIG. 1 and FIG. 2 of the

reference, Marquardt's feedback path is connected between the power switch output and gate terminal and clearly does not connect the power switch output to an output amplifier stage of the drive device (6). Therefore, because the limitations of amended claim 7 are not taught either expressly or inherently by the reference, Applicants submit that amended claim 7 is allowable and respectfully requests the Examiner to reconsider and withdraw the rejections of independent claim 7 and its dependent claims.

With respect to the anticipation rejection of independent claim 1, Applicants have canceled claim 1, rewritten claim 5 in independent form incorporating the limitations of claim 1 (as amended to address the Examiner's objections to claim 1 as originally presented), and amended claims 2-4 to depend on claim 5. In addition, Applicants have modified the limitation originally presented in claim 5 to recite that the voltage at the freewheeling device is fed back via a feedback path to an output amplifier stage of a gate driver connected to the control terminal of the semiconductor power switch. For reasons analogous to those indicated above with respect to independent claim 7, Applicants submit that claim 5 as rewritten and amended recites limitations not taught either expressly or inherently by the cited reference. Applicants respectfully request the Examiner to recognize the allowability of claim 5 as presented and its dependent claims.

With respect to dependent claim 6, Applicants have rewritten the claim in independent form to incorporate the limitations of claim 1 as originally and as amended to recite that the current gradient associated with the free wheeling device is fed back between the control terminal (gate) and the emitter terminal. Applicants submit that the cited reference does not teach either explicitly or inherently all of the limitations of amended claim 6 because Marquardt does not teach a feedback path between the power switch transistor emitter terminal and the power switch transistor control (gate) terminal. The only feedback path disclosed in Marquardt is between the gate and the collector terminals. Therefore, because the cited reference does not disclose all of the features of amended claim 6 reciting a feedback path between emitter and gate, claim 6 as amended is allowable over the cited references.

**Rejections under 35 U.S.C. §103(a)**

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

With respect to the Section §103(a) rejections of claims 11 and 12, Applicants believe that the rejections are moot in view of the amendment to independent claim 7.

Independent claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Marquardt in view of U.S. Patent 6,861,835 issued to Douglas K. Maly et al. ("Maly"). In response, Applicants respectfully request the Examiner to withdraw Maly as a prior art reference. Maly's priority date, which is December 3, 2002 is after the foreign application priority date of the present application, which is July 10, 2002. Accordingly, because Maly is not prior art with respect to the present application, Applicants request the Examiner to reconsider and withdraw the Section 103(a) rejection of independent claim 13 and its dependent claims.

**No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Marquardt* and *Maly* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to

the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

**Declaration and Power of Attorney**

A fully-executed Declaration and Power of Attorney listing Application Serial No. PCT/EP03/006700 is filed herewith.

**Association of Customer Number and Change of Correspondence Address**

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **58174**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **58174**. All telephone calls should be directed to Andreas Grubert at 512.322.2545.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants enclose a Petition for One Month Extension of Time, and authorize the Commissioner to charge the \$120.00 extension fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney, Andreas Grubert, at 512.322.2545.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants



Michelle M. LeCointe  
Reg. No. 46,861

Date: March 14, 2006

SEND CORRESPONDENCE TO:  
BAKER BOTTS L.L.P.  
CUSTOMER ACCOUNT NO. **58174**  
512.322.2545  
512.322.8383 (fax)